

Application No. 09/804,070
Reply to Office Action of November 23, 2007
Amendment dated February 25, 2008

REMARKS

Claims 1, 9, 10, 15, 17-19, 23 and 24 stand rejected while claims 2-8, 20 and 21 stand objected to. Claim 15 has been amended while new claim 26 has been added herein. Therefore, claims 1-10, 15, 17-21, 23, 24 and 26 are pending and at issue. Applicants respectfully request reconsideration of the objections and rejections in view of the following arguments.

As an initial matter, Applicants would like to thank the Examiner for indicating that claims 2-8, 20 and 21 would be allowable if re-written in independent form. However, Applicants have not done so as they believe the claims from which the objected claims depend, are allowable as presented herein.

The disclosure stands objected to regarding an informality in paragraph 13. Applicants have amended the specification to change the word "to" to the word "top" as suggested by the Examiner. Therefore, this objection should be withdrawn.

Claims 1-10 stand objected to as the Office Action alleges that the phrase "said front and rear clamping devices" lacks antecedent basis. However, this phrase does have proper antecedent basis. Specifically, claim 1 recites "...said rear fastener comprising a rear clamping device..." and "...said front fastener comprising a front clamping device..." Therefore, the phrase "said front and rear clamping devices" contains proper antecedent basis and this objection should be withdrawn.

Claims 1, 9, 10, 23 and 24 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Reminger in view of Berger. This rejection should be withdrawn as the proposed combination is improper and fails to disclose or suggest one or more features recited in the claims.

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The Office Action correctly acknowledges that Reminger fails to disclose a rear clamping device which is adjustable into gripping engagement with a saddle post and a front clamping device which is adjustable into gripping engagement with a steering post. To overcome this deficiency, the Office Action proposes combining Berger with Reminger. However, this proposed combination is improper. Specifically, the combination of Berger with the primary reference, Reminger, would render Reminger unsuitable for its intended purpose.

The proposed modification cannot render the prior art unsuitable for its intended purpose. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984); *see also* M.P.E.P. 2143.01(v). Furthermore, the proposed modification cannot change the principle of operation of the reference. M.P.E.P. 2143.01(vi). Moreover, where the "suggested combination of references would require a substantial reconstruction and redesign of the elements shown in [the primary reference] as well as a change in the basic principle under which the [primary reference] construction was designed to operate," the rejection is improper and should be withdrawn. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

The entire disclosure of Reminger is directed to a carrier which is quickly and easily installed on a bicycle without the need of tools. In fact, Reminger specifically addresses the deficiencies in other prior art that make the devices complex and difficult to secure to the bike requiring "attaching a number of bracing members to the handlebars or to the frame by nuts, bolts, or screws, through the use of hand tools." Column 1, l. 20-22. Furthermore, Reminger addresses the advantages of the present invention over the prior art, stating "advantages of the present invention include the ease of installation (without tools)..." Column 2, l. 15-16. In fact, "the very simple installation procedure precludes the need for any wrenches, screwdrivers, pliers, of the like in the quick installation and removal of the carrier." Column 1, l. 54-58 (emphasis

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added). Therefore, the device in Reminger is designed for the specific purpose of being quickly installed without the need for tools, such as for, screws, nuts, etc.

Berger, on the other hand, uses such nuts and bolts, therefore requiring tools. In fact, the structure the Office Action has attempted to incorporate from Berger specifically requires nuts, bolts and the like and necessitates the use of tools, contrary to the intended purpose of Reminger. For this reason alone, the rejection is improper and should be withdrawn.

Moreover, the proposed combination of Berger with Reminger would require substantial redesign of the quickly assembled elements on Reminger which to not require tools. Referring to Figure 6, Reminger includes a slidable member 24 which can contact the rear post. Reminger would require significant redesign to even attempt to accommodate the structure shown in Figure 9-10 of Berger. Such required redesign is impermissible. Furthermore, assuming the structure was significantly redesigned, the clamp from Berger itself might still be adjustable, but the location of the clamp, when placed in the structure of Reminger, would no longer be adjustable. Moreover, Reminger operates by sliding the notched end forward and depressing the rear end of the carrier to hold the carrier firmly in place. Column 3, l. 31-38. This simple operation would have to be significantly modified to accommodate the structure of Berger. Therefore, for these additional reasons, the rejection is improper and should be withdrawn.

Furthermore, assuming *arguendo* that the combination were proper, the proposed combination still fails to disclose or suggest one or more features recited in the claims. Claims 1 and 23 recite a rear clamping device which is adjustable into gripping engagement with a saddle post and a front clamping device which is adjustable into gripping engagement with a steering post. At best, Berger discloses only a front clamping device as the structure in Berger only attaches at the steering post of the bicycle. The Office Action has already admitted that

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Reminger fails to disclose any clamping devices whatsoever. Therefore, for this additional reason, the rejection is improper and should be withdrawn.

In view of the above, the rejection of claims 1, 9, 10, 23 and 24 should be withdrawn and the claims allowed.

New claim 26 has been added incorporating the many of the features of claim 1 and objected claim 3. For similar reasons to those presented above, claim 26 should also be allowed.

The rejection of claims 15 and 17-19 is unclear. The Office Action indicates that "claims 15 and 17-19 are rejected under 35 U.S.C. 102(b) as being anticipated" but continues stating the rejection is by Nauman et al. in view of Jefferson. Furthermore, the Office Action highlights the deficiencies of Nauman et al. and cites Jefferson such that "it would have been obvious to one of ordinary skill in the art..." Therefore, while initially indicating an anticipation rejection under § 102(b), Applicants believe the correct rejection is under § 103(a) and will discuss it as such.

Claim 15, from which claims 17-19 depend, has been amended to recite the elongate support defining a longitudinally extending channel, said channel positionable above and facing a top tube of said bicycle when said bicycle is a male style bicycle. As readily seen in the figures, both Nauman et al. and Jefferson fail to disclose such structure. In fact, Nauman et al. discloses completely different structure, tube 30, having inside and outside tubular structures. Such structure cannot reasonably be interpreted to have the recited features found in claim 15. Jefferson similarly fails in this regard. Therefore, as Nauman et al. and Jefferson, when each taken alone or in combination, fails to disclose or suggest one or more features recited in claims 15 and 17-19, the rejection should be withdrawn and the claim allowed.

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CONCLUSION

The Patent Office is authorized to deduct any fees from Deposit Account No. 19-1351 to cover the additional independent claim added herein. If such a withdrawal is made, please indicate the attorney docket number (31521-400500) on the account statement.

Respectfully submitted,

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